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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/707,787

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Valtann Ayres

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EXAMINER

NGUYEN, CAMTU TRAN

ART UNIT

PAPER NUMBER

3772

MAIL DATE

DELIVERY MODE

12/13/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/707,787

Applicant(s)

AYRES, VALTANN

Examiner

Camtu T. Nguyen

Art Unit

3772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Amendment***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/9/2007 has been entered.

Claim 1 has been amended.

Applicant amended independent claim 1, particularly, to focus on the main body of the device being configured in the shape and contour of the head of the user's penis to form fit the head of the user's penis, such that the top of the main body is longer than the bottom of the main body. Applicant directed to Figure 1 showing such newly cited limitation.

Applicant's primary argument is that the devices of Yahr and Velaquez, applied in the previous Office Action, are bulbous that are not contoured to the shape of the penis. Applicant's arguments directed to the cited references have been carefully studied but deemed not persuasive.

Generally, differences in concentration, temperature, size, or pressure will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration, temperature, size, or pressure is critical. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable

ranges by routine experimentation.” In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). See MPEP 2144.05 (II).

The Yahr’s abbreviated condom’s (10) is of a latex material or a rubber material (column 3 lines 31-33), which yields the shape of the object it protects or cover. In this case, the Yahr’s abbreviate condom (10) will contour to take the shape of user’s penis, such that when applied on the user’s penis, the top edge of the condom is longer than the bottom edge of the condom.

Similiarly, the Velaquez’s condom container is of latex material (column 4 lines 3-7). For the same reasons provided above relating to the latex material, the Velaquez condom container will contour of the head of the user’s penis to form fit the head of the user’s penis, such that the top of the main body is longer than the bottom of the main body.

For the reasons presented above, the rejections applied in the previous Office Action stand rejected.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9 and 11-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yahr (U.S. Patent No. 4,820,290), and further in view of Velaquez (U.S. Patent No. 6,699,226). Yahr discloses in Figures 1-8 an abbreviated condom fitting over the penis head comprising elements as recited in these claims including a hood (12) or main body of condom and a band

(14). Figure 6 illustrating the hood (32) including a projecting nipple (36) which forms an end receptacle for reservoir for collection and retention of ejaculated semen and with which is unitary to the body (12). The Yahr embodiments are preferred to be a latex or a rubber material. Figure 7 illustrating the band (34) serves as a securing means for attaching the condom device to the user's penis head but does not teach the band (34) is with adhesive. Velaquez discloses a container device for collecting semen, the container has an opening that fits over the penis gland, and the device has a securing means in the form of an adhesive that detachably adheres the device to the penis, thereby, preventing the device from detaching during operation. In particular, Figure 3a-3c illustrates the container device with adhesive strip having tab. With regards to claim 11, the Velaquez container in certain embodiments, the adhesive may be replaced or supplemented by a band of elastic material and/or making the container of an elastic material (column 5 lines 44-47). With regards to claims 12-16, Figure 3a shows the adhesive attached to container device via a cushion and the adhesive is covered by a protective strip and Figure 3b illustrates the protective strip is removed when the container device is ready to be applied on the user's penis head. With regards to claim 16, the container body is wide. Therefore, one of ordinary skill in the art during the time of the invention would have been motivated to modify the Yahr's secure means to include Velaquez's secure means in the form of adhesive strip as such would provide better attachment of the device to the user's penis head.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Camtu T. Nguyen whose telephone number is 571-272-4799. The examiner can normally be reached on (M-F) 8:30-5:00.

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Bianco can be reached on 571-272-4940. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*CT Nguyen*  
Camtu Nguyen  
December 9, 2007

*Patricia Bianco*  
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12/10/07